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November 24, 2003

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AND AGENCIES

Commissioner of Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Re: Information Disclosure Statement
Appl. No.: 10/622,779
Filed: July 21, 2003
Title: **Process for Monoalkylation of C-H
Acidic Methylene Groups**
Inventor(s): Bodmann, *et al.*
Atty. Dkt.: 7601/80401

Sir:

The following documents are being forwarded for appropriate action by the U.S. Patent and Trademark Office:

1. Information Disclosure Statement;
2. Form PTO-1449, List of References Cited by Applicant;
3. References AG1-AK1 and AL1-AQ1; and
4. Return Postcard.

Commissioner of Patents
November 24, 2003
Page 2

Applicants do not believe that any fees are due for the filing of this Information Disclosure Statement. However, the Commissioner is hereby authorized to charge any fee deficiency with respect to this filing and any other fee required in connection with the present case, or credit any overpayment, to our Deposit Account No. 06-1135 under Order No. 7601/80401.

It is respectfully requested that the enclosed postcard be stamped with the date the enclosed documents are received by the PTO and that it be returned as soon as possible.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

A handwritten signature in black ink, reading "Michael A. Sanzo". The signature is written in a cursive, flowing style.

Michael A. Sanzo
Attorney for Applicants
Registration No. 36,912

MAS:ct
Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Bodmann, *et al.*

Appl. No.: 10/622,779

Filed: July 21, 2003

For: **Process for Monoalkylation of C-H
Acidic Methylene Groups**



Art Unit: to be assigned

Examiner: to be assigned

Atty. Dkt.: 7601/80401

Information Disclosure Statement

Commissioner of Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Submitted herewith is a listing of documents known to Applicants and/or their attorney in compliance with the requirements of 37 C.F.R. § 1.56. These references were cited in an Office Action in the counterpart German application, an English translation of which is enclosed. Copies of the listed document are also enclosed.

In accordance with 37 C.F.R. § 1.98(a)(3), Applicants' undersigned attorney submits the following concise explanation of the relevance of the non-English language document cited on the accompanying form:

Reference AG1, European patent document no. EP 69648, describes a method for preparing fatty acids labeled with radioactive iodine. The labeled compounds are prepared from brom- or iodo- fatty acids and can be used to study cardiac metabolism by scintigraphy. An English language abstract of this document is cited on the accompanying list of references as

document AL1. A corresponding United States patent (U.S. 4,476,106) is included herewith and is cited on the accompanying list of references as document AA1.

Reference AH1, German patent document no. DE 19752041, describes the C-alkylation of malonic acid dialkyl esters. An English language abstract of this document is cited on the accompanying list of references as document AM1. A corresponding United States patent (U.S. 6,262,298) is included herewith and is cited on the accompanying list of references as document AC1.

Reference AI1, German patent document no. DE 19963115, describes a method for preparing 1,1-cyclopropanedicarboxylic diesters. An English language abstract of this document is cited on the accompanying list of references as document AN1. A corresponding United States patent (U.S. 6,462,224) is included herewith and is cited on the accompanying list of references as document AD1. In addition, a corresponding published U.S. application is included herewith and is cited on the accompanying list of references as AE 1.

Reference AJ1, German patent document DE 3401913, describes a method for preparing 3-hydroxy-octanoic acid from 1,6-dichloro-hexane and a dialkyl malonate via 6-acetoxihexyl-malonic acid dialkyl ester. An English language abstract of this document is cited on the accompanying list of references as document AO1.

Reference AK1, German patent document no. DE 4326917, describes a method for preparing new or known cyclopropane-1,1-dicarboxylate esters. The compounds are useful as intermediates for pharmaceuticals and insecticides. An English language abstract of this document is cited on the accompanying list of references as document AP1. A corresponding United States patent (U.S. 5,510,509) is included herewith and is cited on the accompanying list of references as document AB1.

Applicants does not waive any rights to appropriate action to establish patentability over any of the listed documents should they be applied as references against the claims of the present


application. This statement should not be construed as a representation that more material information does not exist or that an exhaustive search of the relevant art has been made.

Consideration of the cited documents and making the same of record in the prosecution of the above-captioned application are respectfully requested.

Applicants do not believe any fee is due for the submission of this Information Disclosure Statement. However, the Commissioner is hereby authorized to charge any fee deficiency to our Deposit Account No. 06-1135 under Order No. 7601/80401.

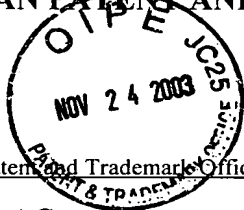
Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By 
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GERMAN PATENT AND TRADEMARK OFFICE



German Patent and Trademark Office @ 80297 Munich

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Munich, July 4, 2003
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File no.: 102 33 507.9 - 44
Your reference: 020263 0C
Applicant no.: 12124141
Degussa AG

[Stamp: Received at
Intellectual Property Management
18 JULY 2003
WOLFGANG Location]

Please note your file number and the applicant
in all correspondence and payments.
Relevant information is marked [x] and/or filled out!

**Request for an examination, payment date on July 24, 2002
Submission of received on**

The subsequent examination of the aforementioned patent application led to the following results.

A period of

**12 month(s), F: July 18, 2004
[illegible]**

which commences with service, has been granted for comments.

For documents, which are also attached to the comments (e.g. specification, parts of the specification, patent claims, drawings), two copies must be submitted on separate sheets. Only one copy of the comments themselves is necessary.

If the specification, the patent claims, or the drawings are amended in the course of the procedure, the applicant shall note in detail where the inventive features, described in the new documents, are disclosed in the original documents, to the extent the amendments were not suggested by the German Patent and Trademark Office.

This communication cites for the first time the following references. (When said references are numbered, this numbering scheme shall also be applicable to the subsequent examination procedure):

Note concerning the Possibility of Branching off the Utility Model

The applicant of a patent application, filed so as to take effect in the Federal Republic of Germany, can file an application for a utility model, relating to the same subject matter, and simultaneously claim the filing date of the earlier patent application. This branching off (§5 of the Utility Model Act) is possible up to the passage of 2 months after the end of the month, in which the patent application is settled with a final rejection, voluntary withdrawal or fictitious withdrawal, an opposition procedure has been terminated or -- if a patent has been granted -- the term for appeal from the decision of grant has passed without results. The notice for applicants of utility models (G 6181), which can be obtained free of charge from the Patent and Trademark Office or its distribution centers, contains detailed information about the requirements for an application for a utility model, including the branching off.

- (1) DE 199 63 115 A1
- (2) DE 197 52 041 A1
- (3) DE 43 26 917 C1
- (4) DE 34 01 913 A1
- (5) EP 0 069 648 A1
- (6) Synth. Commun. 7(8), pp. 559 - 568 (1977)

To date we have not been able to find any material that clearly goes beyond the prior art cited by the applicant. To date the examiner has the cited literature "Zh. Org. Khim." [= Zhurnal Organicheskoi Khimii) only in the original Russian. Hence, would you please have a translation made of this document for the file.

The current results of comparable tests reveal that the subject matter of the application to the extent of the examples has obviously also inventive merit. However, the current claim 1 should be described in more detail with the information of the applicable claim 4, since it cannot be inferred from the examples that the process can be applied to arbitrary CH acid compounds. This also applies analogously and appropriately to the current claim 10.

Hence, the present documents do not hold out the prospects of a patent being granted.

Examiner for class C 07 B

[signature]

Dr. Hartmut Fetzer

Extension: 4234

Enclosure: Copies of the documents cited

LIST OF REFERENCES CITED BY APPLICANT <i>(Use several sheets if necessary)</i>				Atty. Docket No.: 7601/80401		Appl No.: 10/622,779	
				Applicant(s) Bodmann, <i>et al.</i>			
				Filing Date: July 21, 2003		Group: to be assigned	

U.S. PATENT DOCUMENTS							
Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date If Appropriate	
	AA 1	4,476,106	Oct. 9, 1984	Bardy, <i>et al.</i>	424	1.1	Jun. 28, 1982
	AB 1	5,510,509	Apr. 23, 1996	Steffen	560	124	Aug. 8, 1994
	AC 1	6,262,298 B1	Jul. 17, 2001	Metz, <i>et al.</i>	560	203	Nov. 24, 1998
	AD 1	6,462,224 B2	Oct. 8, 2002	Harthun, <i>et al.</i>	560	124	Dec. 19, 2000
	AE 1	2001/0007040 A1	Jul. 5, 2001	Harthun, <i>et al.</i>	560	124	Dec. 19, 2000
	AF						

FOREIGN PATENT DOCUMENTS								
Examiner Initial	Document Number	Date	Country	Class	Subclass	Trans./Abstr.		
						Yes	No	
	AG 1	EP 0 069 648 A1	Jan. 12, 1983	EPO	C07B	23/00	X	
	AH 1	DE 197 52 041 A1	May 27, 1999	Germany	C07C	69/38	X	
	AI 1	DE 199 63 115 A1	Jul. 12, 2001	Germany	C07C	67/343	X	
	AJ 1	DE 3401913 A1	Aug. 1, 1985	Germany	C07C	59/01	X	
	AK 1	DE 43 26 917 C1	Aug. 11, 1993	Germany	C07C	67/343	X	

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)		
Examiner Initial	Document Number	Description
	AL 1	English language abstract for EP 0 069 648, Reference AG1 above.
	AM1	English language abstract for DE 197 52 041, Reference AH1 above.
	AN 1	English language abstract for DE 199 63 115, Reference AI1 above.
	AO 1	English language abstract for DE 3401913, Reference AJ1 above.
	AP 1	English language abstract for DE 43 26 917, Reference AK1 above.
	AQ 1	WHITE, "Alkylations with Potassium Carbonate in Dimethylformamide," <i>Synthetic Communications</i> 7(8):559-568 (1977).
	AR	

Examiner	Date Considered
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